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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 3612

In re Patent Application of

Stefan Huedepohl

Application No. 10/658,038

Confirmation No.: 2020

Filed: September 9, 2003

Examiner: Kiran B. Patel

"FOLDABLE TOPS FOR CONVERTIBLE
VEHICLES"

**REQUEST FOR INITIALED COPY OF FORM PTO-1449 UNDER MPEP 609III(C)(2),
ETC., AFTER NOTICE OF ALLOWANCE MAILED 18 OCT 2004**

ACTION BY AND RESPONSE FROM PTO REQUIRED BY DECEMBER 18, 2004

MAIL STOP ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby graciously acknowledges allowance of claims 1-20 and the Notice of Allowance mailed October 18, 2004. However, several administrative matters require clarification before this application is permitted to issue. Therefore, Applicant hereby makes the following requests:

1. Provision of Initialed Copy of Form PTO-1449 filed August 31, 2004.
2. Request for Interview Summary concerning Substantive Discussions between the Undersigned and the Examiner.
3. Clarification of the Basis for Canceling Claims 21-25.

1. Initialed Copy of Form PTO-1449 filed August 31, 2004

With the Response to Restriction Requirement mailed August 31, 2004, Applicant also submitted an IDS and Form PTO-1449, which lists US Patent Nos. 4,693,509 and 4,784,428 and European Patent Publication No. 0 332 812. As indicated in the IDS, these references were cited in the Search Report for the counterpart European patent application. Therefore, it appears essential to ensure that the record clearly indicates that Applicant satisfied its duty pursuant to MPEP 2001.06(a).

The Form PTO-892 attached to the Notice of Allowance lists US Patent No. 4,693,509, but does not mention the other two above-noted prior art references. Moreover, Applicant's Form PTO-1449 filed August 31, 2004 was not initialed and returned with the Notice of Allowance.

Therefore, because the IDS and Form PTO-1449 filed September 2004 were properly filed in compliance with Rule 97(b)(3), consideration of those references is mandatory according to MPEP 609 and the record should clearly reflect that the Examiner considered those references.

Consequently, an initialed copy of the Form PTO-1449 filed August 31, 2004 is hereby requested. Because a copy of this Form PTO-1449 can be obtained from the PTO PAIR site (Information Disclosure Statement dated September 3, 2004), it is believed unnecessary to provide another copy herewith.

2. Request for Interview Summary

In accordance with the requirements of MPEP 714.03, Applicant makes of record the substance of three telephone interviews initiated by the Examiner before the Notice of Allowance was issued. It is noted that an "Examiner Initiated Interview Summary" was not provided with the Notice of Allowance:

- 1) On October 1, 2004, the Examiner telephoned the undersigned and left a message on the undersigned's voice mail requesting a telephone interview. Upon receipt of this message the same day, the undersigned telephoned the Examiner. The Examiner stated that he was having difficulty identifying support in the specification and drawings for claims 3, 7, and 11. The undersigned stated that it would be necessary to review the file in greater detail to provide assistance to the Examiner.

2) On October 5, 2004, the undersigned telephoned the Examiner and left a message on the Examiner's voice mail regarding the specification issues. Later the same day, the Examiner telephoned the undersigned, and the undersigned identified to the Examiner where representative, but not limiting, support in the specification for claims 3, 7 and 11 could respectively be found, e.g., in paragraphs [0036], [0039] and [0043].

3) On October 8, 2004, the Examiner telephoned the undersigned and requested authorization to amend claims 2-20 in order to replace "A" with "The." As this amendment has absolutely no effect on the scope or interpretation of the claims (i.e., it is a purely cosmetic change), the undersigned authorized this amendment.

The Examiner then requested authorization to cancel claims 21-25. The undersigned advised the Examiner that the undersigned did not have authority to authorize such cancellation of claims 21-25 and that it would be necessary to contact the German Assignee of this application to determine whether such authorization could be provided. The Examiner indicated that he did not have time to wait for such authorization.

No further contacts occurred between the undersigned and the Examiner between October 8, 2004 and October 18, 2004.

If necessary, a more complete transcript of these telephone discussions can be provided.

As it is believed that substantive matters were discussed in these telephone interviews, in accordance with MPEP 713.04, Applicant requests an "Examiner Initiated Interview Summary" so as comply with 37 CFR 1.2.

Finally, it is requested that all further communications for this application be made in writing.

3. Clarification of Basis for Canceling Claims 21-25

As noted above, the undersigned advised the Examiner that he did not have authority to cancel claims 21-25 and that it would be necessary to contact the German client for such authorization. However, paragraph 1 of the Examiner's Amendment and Examiner's Statement

of Reasons for Allowance appears to indicate that authorization was provided for cancellation of claims 21-25.

To the contrary, the record should reflect that Applicant maintains its position concerning claims 21-25 as provided in the Response to Restriction Requirement mailed August 31, 2004.

Consequently, the record is unclear as to the basis for canceling claims 21-25, which could become detrimental to the Applicant if not properly clarified. For example, according to 35 U.S.C. 121, third sentence, a double patenting rejection can not be made if the divisional application resulted from a requirement for restriction made under Section 121. Thus, the Section 121 prohibition on a double patenting rejection applies only where the Office has made a restriction requirement.

On the other hand, in accordance with MPEP 804.01, “[t]his prohibition does not apply where the divisional application was voluntarily filed by the applicant and not in response to an Office requirement for restriction.” MPEP 804.01 then continues as follows:

“This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.” (Emphasis added)

Because the Applicant has not acquiesced to the restriction requirement made in the Office Action mailed August 2, 2004, and did not authorize cancellation of claims 21-25, the record lacks clarity as to the basis for such cancellation. In particular, it does not appear that MPEP 1302.04 provides any authority for canceling claims without the Applicant’s authorization.

Moreover, such lack of clarity could detrimentally impact the Applicant, e.g., if a divisional application were to be “voluntarily” filed in a situation in which the Applicant has argued against the propriety of the restriction requirement, yet the restriction requirement was never made final.

Furthermore, according to Rule 144, it is not possible to request reconsideration of a restriction requirement until the restriction requirement has been made final. Therefore, by not

utilizing the procedures provided by MPEP 812.01 (i.e., elected claims found allowable after traverse was made) and 821.01, the Applicant has been deprived of the right to petition against the restriction requirement. It is not presently understood what authority allows this deprivation of rights.

Therefore, if the Examiner still holds the opinion that the restriction requirement is proper, Applicant requests a point-by-point reply, as required by MPEP 821.01, to the reasons or arguments presented by the Applicant in the traverse filed on August 31, 2004 so that Applicant can be adequately informed of the Examiner's grounds for unilaterally canceling claims 21-25.

In the alternative, withdrawal of the restriction requirement and examination of claims 21-25 in the present application is again respectfully requested.

In this regard, it is noted that, according to the Examiner's search notes, both Class 296, Subclass 107.07 and Class 296, Subclass 107.12 were searched for this application on October 8, 2004. Since the Examiner searched both classifications, the apparent primary basis for requiring restriction (i.e., separate classifications of claims 1-20 and 21-25) made in the Restriction Requirement of August 2, 2004 appears to have been mooted thereby. As a result, it is still not clear what "serious burden" (MPEP 803) prevents examination of claims 21-25 in this application.

In addition, because the above search notes contradict the position taken in the Restriction Requirement of August 2, 2004, significant questions have been created as to the basis for canceling claims 21-25, which questions could detrimentally affect the enforcement of the present claims 1-20, as well as the future proceedings concerning cancelled claims 21-25.

Furthermore, in view of the fact that claims 4, 5, 19 and 20 have now been allowed, the record should be clear as to the Examiner's basis for restricting claims 21-23 therefrom. Naturally, method claims 24-25 also should be examined herein, as claims 21-23 serve as linking claims according to MPEP 809.03 (Example C).

In view of the above, examination and allowance of claims 21-25 in this application is again respectfully requested.

4. Request for Prompt Attention

It is respectfully requested that these matters be resolved within 2 months from the mailing date of the Notice of Allowance.

As the Issue Fee payment deadline can not be extended, prompt attention to this matter is respectfully requested to clarify the record. Applicant wishes to avoid the necessity of filing a petition under MPEP 1306.01 to defer issuance of the patent after payment of the Issue Fee, such deference being requested in view of the extraordinary circumstances involved with this application. In addition, as it appears that the above-noted problems were unintentional mistakes that can be easily remedied, it is believed that a Petition under 37 CFR 1.181(a)(3) can be avoided.

Respectfully submitted,

STEFAN HUEDEPOHL



Mark A. Ussai
Reg. No. 42,195

File No. 016382-9005
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(610) 798-2179